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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,795	04/02/2002	Takashi Hayama	2002-0054A	1703

513 7590 09/24/2003  
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[REDACTED] EXAMINER

HABTE, KAHSAY

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1624

DATE MAILED: 09/24/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/031,795	HAYAMA ET AL.	
<b>Examiner</b>	<b>Art Unit</b>		
Kahsay Habte, Ph. D.	1624		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 29 July 2003 .

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-10 is/are pending in the application.

4a) Of the above claim(s) 4 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-3 and 7-10 is/are rejected.

7)  Claim(s) 5-6 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.      6)  Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-10 are pending.

***Election/Restriction***

2. Applicant's election with traverse of Group II, Claims 1-3 and 7-10 in Paper No. 11 is acknowledged. The traversal is on the ground(s) that the present claims satisfy the unity of invention and all of the compounds have the same utility. Applicants argue that Group II, Group IV and spirooxazole of Group IX are the same because they have 1,3-oxazole. The examiner disagrees with applicants. The special technical feature of each group is different one from the other. The only fragment common to all groups is the substituted. In regard applicant's argument that Group II, IV and Group IX are the same because they have 1,3-oxazole, the examiner disagrees because Group II is drawn to 1,3-oxazine (6-membered ring) not 1,3-oxazole (5-membered ring). Furthermore coexamination of each of the additional groups would require search of subclasses unnecessary for the examination of the elected claims. For example, the search for the invention of Group IV would include search of class 548, the search for the invention of Group IX would include search of classes 544 and 548. Therefore, coexamination of each of these additional inventions would require a serious additional burden of search.

The requirement is still deemed proper and is therefore made FINAL.

***Objection***

3. Claims 5-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants also have to delete non-elected subject matter from said claims to overcome the objection.

***Non-elected Invention***

4. The claims are drawn to multiple inventions for reasons set forth in the restriction requirement. The claims are examined only to the extent that they read on the elected invention. Cancellation of the non-elected subject matter is recommended in response to this Office Action.

***Information Disclosure Statement***

5. The IDS (Paper No. 4) was not initialed because the PTO Form 1449 and the references are missing. The examiner kindly request applicants to provide the 1449 and references. Note that the IDS (Paper No. 7) has been initialed and attached with this Office Action.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

- a. Claim 1 and claims dependent thereon are rejected because in claim 1 (line 9) the term "pyradinyl" is not clear. What is it? Is this pyridyl or piperidinyl? Likewise the same problem exists elsewhere in the claims (e.g. in claim 2 (line 16)).
- b. In claim 7 (line 1), the term "compuns" should read as "compounds."
- c. In claim 10 (page 539, line 9), the word "conbined" should read as "combined."

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (703) 308-4717. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Kahsay Habte, Ph. D.  
Examiner  
Art Unit 1624

*Mukund J. Shah*  
Mukund J. Shah  
Supervisory Patent Examiner  
Art Unit 1624

KH  
September 20, 2003